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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/596,697  | 06/21/2006  | Carlo Gelmetti       | PRINZ S5026                 | 9635             |
| 27667 7590 07/25/2008<br>HAYES SOLOWAY P.C.<br>3450 E. SUNRISE DRIVE, SUITE 140<br>TUCSON, AZ 85718 |             |                      | EXAMINER<br>GEHMAN, BRYON P |                  |
|   |             |                      | ART UNIT                    | PAPER NUMBER     |
|   |             |                      | 3728                        |                  |
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|   |             |                      | 07/25/2008                  | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/596,697

**Applicant(s)**

GELMETTI, CARLO

**Examiner**

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-26, 28-43 and 46-48 is/are pending in the application.  
4a) Of the above claim(s) 29, 31-33 and 38 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 24-26, 28, 30, 34-37, 39-43 and 46-48 is/are rejected.  
7) ☒ Claim(s) 37 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 25 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

1. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56. Applicants are advised that, notwithstanding the preceding waiver, an applicant who has not disclosed information that is material to patentability as defined in 37 CFR 1.56, because it was believed that the information was not "material to the examination," should disclose such information in order to discharge the applicant's duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

2. The replacement drawings were received on April 25, 2008. These drawings are accepted.

3. Applicant's election with traverse of Species I in the reply filed on April 25, 2008 is acknowledged. The traversal is on the ground(s) that the examiner has already considered all of the claims. This is not found persuasive because such does not render the individual species as a single inventive concept.

The requirement is still deemed proper and is therefore made FINAL.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 24-26, 28, 30, 34-37 and 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 24, line 1, "having an upper surface" is indefinite whether such refers to the antecedent cover or container. Accordingly, "having" should be preceded by –the cover–. In lines 3-4, "a spacer which divides the slot into an inner portion and an outer portion" has no antecedent basis for a relative "inner" or "outer" relationship.

In claim 37, the reference to imaginary welding wire renders the claimed subject matter indefinite.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 24-26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Epstein (2,580,900). Disclosed is a cover (15) having an upper surface provided with an

elongated slot (19) having a spacer (23) which divides the slot. With respect to the referencing to welding wire and a container, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As to claim 25, the disclosed spacer is of a material of less strength than welding wire and would be rupturable thereby.

As to claim 26, the pasting of the spacer indicates its attachment is not absolutely permanent.

As to claim 28, the disclosed spacer is flexible and inherently deflectable.

8. Claims 24-26 and 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitt et al. (4,451,014). Claims 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Frederick et al. (3,823,894). Claims 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenson (3,096,951). Each discloses a cover (16; 44; 16; respectively) for a welding wire container having an upper surface provided with an elongated slot (74; receiving 30; receiving 42) through which welding wire may be withdrawn from the container, and a spacer (66; 30; 42) defining an inner portion (at base of 60; lower end of 30; lower end of 42) and an outer portion (at the top of 60; outer end of 30; 44) so that welding wire extending through the inner portion of the slot is held spaced from welding wire extending through the outer portion of the slot.

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As to claim 25, in each case the disclosed spacer is of a material of less strength than welding wire and would be rupturable thereby.

As to claim 26, each discloses the spacer to be detachable from the cover.

As to claims 39 and 40, Kitt et al. disclose an elevated portion (at 60) as a truncated cone.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Kitt et al. and Frederick in view of Priest (4,274,607). Neither of Kitt et al. and Frederick discloses the spacer thereof being deflectable as claimed. However, Priest discloses a spacer (32) formed so as to be deflectable (at 58a) to allow wire to pass the spacer in the deflected condition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the cover of either one of Kitt et al. and Frederick with the spacer of Priest as claimed, as such a modification would predictably serve to guide and restrain wire being dispensed through the cover in the manner suggested by Priest in conjunction with wire coil containers. "A combination of familiar elements according to known methods is likely to be obvious when it does no

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more than yield predictable results." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396.

11. Claims 30, 36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein. To comprise the strip as a label and of plastic would fail to distinguish any new or unexpected result by such an arrangement. To have the slot of a certain width would be within the level of ordinary skill in the art to accommodate the intended content.

12. Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitt et al. To modify the elevated portion of Kitt et al. to comprise a truncated pyramid shape as claimed would entail a mere change in shape of the raised portion and yield only predictable results. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1740, 82 USPQ2d 1396 (2007). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

13. Claims 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art employed against claim 24 above. Each reference discloses a slot of unspecified

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dimension. It would have been an obvious matter of design choice to provide a slot of desired size, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

14. Claims 46-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Kitt et al. and Frederick in view of B.-Jensen. Neither of Kitt et al. and Frederick discloses an additional welding wire container. However, B.-Jensen discloses providing two welding wire container is interconnected relationship. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of either one of Kitt et al. and Frederick in the dual container arrangement of B.-Jensen as claimed, as such a modification would predictably serve to guide and restrain wire being dispensed from multiple containers in the manner suggested by B.-Jensen in conjunction with wire coil containers. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396.

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 34 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/279,517. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter of a plate with a slot in a cover is common to both applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

18. Claim 37 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bryon P. Gehman/  
Primary Examiner, Art Unit 3728

Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG